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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,399	09/26/2006	Shaow Lin	DC10103 PCT1	9226

7590 09/05/2008
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EXAMINER

LOEWE, ROBERT S

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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09/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/594,399	Applicant(s) LIN ET AL.	
	Examiner ROBERT LOEWE	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 13, 14 and 16-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 13, 14, 16, 17 and 19-21 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/26/08 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/13/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's arguments/remarks, filed on 6/30/08, have been fully acknowledged.

Claim Interpretation

Instant claim 11 requires a first step of combining ingredients (A) and (B) with water followed by a second step of mixing. It is submitted by the Examiner that combining ingredients (A) and (B) with water would inherently satisfy the limitation "to form an aqueous dispersion". Further, it is submitted by the Examiner that mixing the aqueous dispersion would inherently satisfy the limitation "to form vesicles". These two interpretations are based on the limitations of instant claim 11. Specifically, if a prior art reference, or combination of prior art references, collectively teach combining components (A), (B) and water as claimed, the result would be an aqueous dispersion. Further, mixing of said aqueous dispersion as claimed would "form vesicles" according to instant claim 11. There is currently no claim limitations which would remove a prior art reference(s) which teaches combining components (A), (B) and water followed by mixing. This interpretation of the claims was not previously presented and has resulted in a new ground of rejection, cited below. As such, this Office action is non-final.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 11, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cen et al. (US Pat. 6,632,420) in view of Tsubaki et al. (US Pat. 5,472,686).

Claim 11: Cen et al. teaches a process for making a clear personal care product in the form of a microemulsion (claim 38 of Cen et al.) comprising mixing water (6:59), an alcohol (6:65-67) such as ethanol (6:61), and an AB-type silicone polyether (5:21-23). Cen et al. further teaches mixing the ingredients to form a microemulsion (example 2).

Cen et al. does not teach that the silicone polyether graft copolymer is of the $(AB)_n$ type of instant claim 11. However, Tsubaki et al. does explicitly teach $(AB)_n$ block silicone polyether copolymers which have the structural limitations of instant claim 11 [reaction (a) at the bottom of columns 3 and 4]. Cen et al. and Tsubaki et al. are combinable because they are from the same field of endeavor, namely, personal care compositions comprising silicone polyether copolymers. At the time of the invention, a person having ordinary skill in the art would have found it obvious to employ the $(AB)_n$ block silicone polyether copolymers as taught by Tsubaki et al. into the aqueous microemulsions as taught by Cen et al. and would have been motivated to do so because Tsubaki et al. teaches the advantages that the $(AB)_n$ block silicone polyether copolymers have in various cosmetic formulations when compared to the graft silicone polyether

copolymers and ABA block silicone copolymers such as those taught by Cen et al. (control examples 9, 12, 13, 16, 18, 20, 22 and 24 of Tsubaki et al.).

Because Cen et al. in view of Tsubaki et al. collectively teach the claimed ingredients of instant claim 11, and further teaches the process limitations of instant claim 11, it follows that the process taught by Cen et al. is capable of forming vesicles. The courts have stated that "Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established." Further, if it is the applicant's position that this would not be the case: (1) evidence would need to be provided to support the applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties (i.e., formation of vesicles) with only the claimed ingredients.

Claims 13 and 14: Cen et al. teaches a personal product (antiperspirant) resulting from the process of instant claim 11 (example 1).

Claims 16 and 17: Cen et al. further teaches the addition of a volatile methylsiloxane oil to the composition (claim 38).

Claim 19: Cen et al. further teaches that step (I) of instant claim 11 comprises a healthcare active (example 1, AZCH, which is an aluminum salt in the antiperspirant composition of Cen et al.).

Claims 20 and 21: Cen et al. teaches a personal product (antiperspirant) resulting from the process of instant claim 11 (example 1).

Response to Arguments

Applicant's arguments have fully considered but they are not persuasive. Specifically, Applicants argue that Cen et al. fails to teach that the process for forming vesicles by first mixing an alcohol with an $(AB)_n$ block copolymer as claimed. The Examiner does not disagree with this statement since Cen et al. does not explicitly teach $(AB)_n$ silicone polyethers. However, Cen et al. does explicitly teach that an alcohol such as ethanol is combined with water and a silicone polyether. It would therefore have been obvious to add the alcohol component in the same way when employing the $(AB)_n$ block silicone polyethers as taught by Tsubaki et al.-that is, along with water and the $(AB)_n$ block silicone polyether, thus satisfying all of the limitations of the base claim.

Because of the new grounds of rejection cited above, this Office action is non-final. In the previous Office action, the Examiner had relied on Hill et al. in the rejection of instant claim 12. Instant claim 12 has been cancelled and its limitations have been incorporated into independent claim 11. However, owing to the claim interpretation above, Hill et al. is **not** relied upon in the rejection of instant claim 11.

Allowable Subject Matter

Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Specifically, none of the above applied references teach or suggest that the volatile siloxane oil is a vinyl functional organopolysiloxane.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT LOEWE whose telephone number is (571)270-3298. The examiner can normally be reached on Monday through Friday from 5:30 AM to 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-13021302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. L./

Examiner, Art Unit 1796

25-Aug-08

/Randy Gulakowski/

Supervisory Patent Examiner, Art Unit 1796